

## REMARKS

Favorable reconsideration and withdrawal of the objections and rejections set forth in the above-mentioned Official Action in view of the foregoing amendments and the following remarks are respectfully requested.

### Drawings

Figure 7 is objected to because it does not include the label --PRIOR ART--.

In response, a Submission of Corrected Sheet of the Drawings is being filed concurrently herewith in which the label --PRIOR ART-- has been added to Figure 7. No new matter has been added. It is respectfully submitted that the objection to the drawings has been overcome.

### Specification

The specification is objected to because of minor informalities noted by the Examiner. The specification has been amended to attend to any informalities, including those kindly identified by the Examiner. It is respectfully submitted that no new matter has been added.

### Claims Status

Claims 1 through 23 remain pending in the application. Claims 1, 13, and 22 have been amended to even more succinctly define the invention and/or to improve their form. It is respectfully submitted that no new matter has been added. Claims 1 and 13 are the only independent claims pending in the application.

### Claim Objection

Claim 22 is objected to for the reasons set forth in the Official Action. In response, Claim 22 has been amended to overcome the grounds of the objection. It is respectfully submitted that no new matter has been added and that the objection has been overcome.

### Art Rejections

Claims 1, 5, and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,163,663 (Shinohara, et al.).

Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara, et al. as applied to Claim 1 in view of Japanese Laid-Open Patent Application No. 2002-278262.

Claims 4, 7, 8, 13, 16, 18, 19, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara, et al. in view of U.S. Patent Application Publication No. 2003/0152856 (Mizoe, et al.).

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara, et al. as applied to Claim 1 in view of U.S. Patent No. 6,391,511 (Okamoto, et al.).

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara, et al. and Mizoe, et al. as applied to Claim 13 and further in view of Okamoto, et al.

Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara, et al. as applied to Claim 1 and in view of U.S. Patent Application Publication No. 2004/0157735 (Hare).

Claims 20 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara, et al. and Mizoe, et al. as applied to Claim 13 and further in view of Hare.

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara, et al. as applied to Claim 1 in view of U.S. Patent No. 6,586,151 (Naka, et al.).

Claims 14 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara, et al. and Mizoe, et al. as applied to Claim 13 and further in view of Japanese Laid-Open Patent Application No. 2002-0278262.

Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara, et al. and Mizoe, et al. as applied to Claim 1 and further in view of Naka, et al.

The rationale underlying each of the foregoing art rejections is succinctly set forth in the Official Action.

#### Response to Art Rejections

The rejections are respectfully traversed.

Amended Claim 1 calls for a developing apparatus that includes a developer carrying member for carrying a developer; a developer regulating member, contacted to said developer carrying member, for regulating a thickness of a layer of the developer on the developer carrying member; and a lubricant provided, before the developing apparatus begins being used, between the developer carrying member and the developer regulating member. The charge polarity of the lubricant is opposite to a charge polarity of the developer, and a weight average particle size of the lubricant is not more than 1/3 of a weight average particle size of the developer.

In Claim 1, specific properties of the lubricant are defined by a charge polarity of said lubricant is opposite to a charge polarity of said developer, and a weight average particle size of said lubricant is not more than 1/3 of a weight average particle size of the developer of a surface of said developer carrying member. In addition, amended Claim 1

recites that the lubricant is provided before the developing apparatus begins being used.

According to these features, an image defect attributable to low image density or ghosts or the like can be avoided.

Shimomura, et al. discloses use of a developer comprising an externally added material. However, the externally added material is not one "provided before said apparatus begins being used" as recited in amended Claim 1. Even if such an externally-added material is used, the developer does not obtain a proper charging level, and therefore, an image defect, such as low density and/or ghosts are not prevented.

It is respectfully submitted that Shimomura, et al. does not expressly disclose at least one of the foregoing claimed features recited in amended Claim 1 and does not anticipate the claimed invention.

Amended Claim 13 calls for a developing apparatus that includes a developer carrying member for carrying a developer; a developer regulating member, contacted to the developer carrying member, for regulating a thickness of a layer of the developer on the developer carrying member; and a lubricant provided, before the developing apparatus begins being used, between the developer carrying member and the developer regulating member. The charge polarity of the lubricant is opposite to a charge polarity of the developer, and wherein a weight average particle size ( $\mu\text{m}$ ) of the lubricant is smaller than an arithmetic average roughness Ra value ( $\mu\text{m}$ ) of a surface of the developer carrying member.

In Claim 13, specific properties of the lubricant are defined by a charge polarity of said lubricant is opposite to a charge polarity of said developer, and wherein a weight average particle size ( $\mu\text{m}$ ) of said lubricant is smaller than an arithmetic average roughness

Ra value ( $\mu\text{m}$ ) of a surface of said developer carrying member. In addition, amended Claim 13 also recites that the lubricant is provided before the developing apparatus begins being used. According to these features, an image defect attributable to low image density or ghosts or the like can be avoided.

Regarding independent Claim 13, the Examiner relies on Mizoe, et al. as a secondary reference and argues that it would have been obvious to one skilled in the art at the time the invention was made to modify Shinohara, et al. to include thereon a weight average particle size ( $\mu\text{m}$ ) of said lubricant is smaller than an arithmetic average roughness (Ra) value ( $\mu\text{m}$ ) of a surface of said developer carrying member. The Examiner argues that the motivation to modify the teachings of Shinohara, et al. with those of Mizoe, et al. is to avoid scattering incident light by the dispersed particles on a photoconductive roller or to obtain the desired resistivity on the developing roller.

The Examiner has provided a *rationalization* for combining the teachings of the cited art based on the benefits of doing so. A combination rejection is proper only when there is some suggestion or motivation in the cited art *per se* to cause one having ordinary skill in the art to combine the teachings of the cited art. There is nothing in the cited art which supports the position that it can be combined in the manner suggested. Even if the art could be so combined, the mere fact that the art can be combined is not sufficient if there is no suggestions in the art that such a combination is desirable. For example, see ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, it is respectfully submitted that the combination rejections are not well founded.

Further, Mizoe, et al. is not understood to provide the lubricant before the developing apparatus begins being used.

The other cited art is noted. Specifically, it is noted Japanese Laid-open Patent Application No. 2000-278262 discloses a lubricant provided before the apparatus begins being used. However, the Japanese patent document does not disclose or suggest the specific properties of the lubricant defined in Claims 1 and 13. Accordingly, it is believed that the claimed invention is allowable over all of the art of record.

In view of the foregoing, it is respectfully submitted that amended independent Claims 1 and 13 are allowable over the cited art whether taken individually or in combination.

#### Dependent Claims

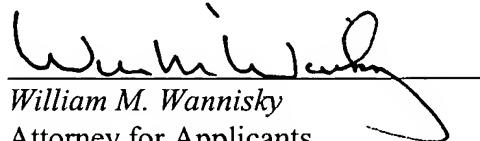
Claims 2 through 12 and 14 through 23 depend either directly or indirectly from one of Claims 1 and 13 and are allowable by virtue of their dependency and in their own right for further defining Applicants' invention. Individual consideration of the dependent claims is respectfully requested.

#### Closing Comments

It is respectfully submitted that the pending claims are allowable over the art of record and that the application is in condition for allowance. Favorable reconsideration and early passage to issue of the present application are earnestly solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our New York office at the address shown below.

Respectfully submitted,

  
*William M. Wannisky*  
Attorney for Applicants  
Registration No. 28,373

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

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